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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/598,557 | 06/21/2000 | Jeffrey G. Bingham | 10001261-1 | 6684 |

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EXAMINER

WALLERSON, MARK E

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| ART UNIT | PAPER NUMBER |
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2626

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,557

Applicant(s)

BINGHAM ET AL.

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13, 15-18 and 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13, 15-18, 20-23, 31-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) 24-30 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2626

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **7/13/05**.
2. This application has been reconsidered. Claims 1-13, 15-18, and 20-39 are pending.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33, 34, 35, 36, 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara (U.S. 5,823,522).

With regard to claims 33, 35, 26 Fujiwara discloses a media handling system comprising a tray (25) which has a media edge registration surface (27); a holder (1) positioned within the tray (figure 6), the holder movable along the media edge registration surface (figure 10A), the holder including a floor configured to extend below media held by the holder (figure 12B), and a first wall, wherein the holder is movable between a first position in which the first wall is configured to face the media edge registration surface while engaging edges of media while

Art Unit: 2626

being movable towards the edge registration surface so as to move media into contact with the edge registration surface and away from the media edge registration surface (figure 10A and 11B).

With regard to claim 34, Fujiwara discloses the holder has a second wall (2a) oblique to the first wall and configured to engage the edges of the media held by the holder (figure 1).

With regard to claim 38, Fujiwara discloses the holder (1) includes a manually operable clamp (clip) for engaging and securing media in the media receptacle (column 4, lines 66-67).

With respect to claim 39, Fujiwara discloses the holder includes a lateral opening configured to permit media held by the holder to laterally project beyond the holder into engagement with the media edge registration surface (figure 12A).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 17, 18, 20, 21, 22, 23, 31, 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (Fujiwara) (U.S. 5,823,522) in view of Trask et al (Trask) (U.S. 5,116,034).

With respect to claim 1, 5, 11, 31, Fujiwara discloses a data processing apparatus comprising a media tray (25) with a media support surface (figure 6) and a media edge

Art Unit: 2626

registration surface (27), a removable media holder (1) having a lower portion contacting the media support surface (which reads on a sheet holder removably attached to a hopper (25) (the abstract) and figure 10B); and the holder defining a media receptacle above the lower portion (figures 6 and 11A), and having a lateral opening facing the registration surface (figures 11A, 11B, and 12B) the opening being configured to permit media in the receptacle to pass through the opening into contact with the registration surface (figures 11A, 11B, and 12B).

Fujiwara differs from claims 1, 5, 11, 24 in that although he discloses that his invention relates to a data processing apparatus **such as** a reading apparatus (emphasis added) (column 1, lines 6-7), he does not clearly disclose that the apparatus is a printer.

Trask discloses a printer comprising an envelope/sheet feeder comprising a removable envelope tray (34) positioned above a sheet feed tray (26), wherein the sheets from both tray may be selectively fed to a registration surface (60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara wherein the feed trays are utilized in a data processing apparatus such as a printer. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara by the teaching of Trask in order to obtain a more compact feeding system.

With regard to claim 2, Fujiwara discloses the media tray is sized to receive conventional letter sized media and the holder is sized to receive smaller media (column 4, lines 55-65 and column 6, lines 39-52).

With respect to claim 3, Trask discloses that the media tray (26), when fully inserted into the printer for printing operations, has a first portion contained in a printer body, and a second portion extending from the printer body (figure 1), wherein the media receptacle is largely

Art Unit: 2626

received in the first portion, wherein the holder has a handle extending from the receptacle and occupying the second portion of the tray (figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara wherein the media tray, when fully inserted into the printer for printing operations, has a first portion contained in a printer body, and a second portion extending from the printer body, wherein the media receptacle is largely received in the first portion, wherein the holder has a handle extending from the receptacle and occupying the second portion of the tray. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara by the teaching of Trask in order to allow the user to have easy access to the tray and holder.

With regard to claims 4, 6, 7, Fujiwara discloses the media tray includes a first registration element (26) defining a surface parallel to the media edge registration surface (27), and wherein the holder (1) includes a second registration element contacting the first registration element (figure 9B).

With regard to claim 8, Fujiwara discloses the edge registration element is movable relative to the holder (the roller, 27).

With respect to claims 9, 13, Fujiwara discloses the edge registration element is biased toward the tray edge registration surface (figure 10A).

With regard to claim 10, Fujiwara discloses the holder (1) includes a manually operable clamp (clip) for engaging and securing media in the media receptacle (column 4, lines 66-67).

With respect to claim 12, Fujiwara discloses the media holder has a profile smaller than that of a conventional letter sized media, such that the holder may be received in the media tray (figure 6).

Art Unit: 2626

With regard to claims 15, 16, 17, Trask discloses the holder includes an edge registration element (64), movable relative to the holder, and at least in part defining the media receptacle, and opposite the edge registration surface of the tray, such that media is laterally constrained by the holder edge registration element and the tray edge registration surface (figure 3).

With respect to claim 18, Fujiwara discloses providing a data processing apparatus having a media tray sized (25) to receive a first size of media, and having an edge registration surface (27); if there is media in the tray, removing the media from the tray positioning in the tray a media holder containing small media of a second smaller size (figures 12A and 12B and column 8, lines 31-47); and abutting the small media against the registration surface (27).

Fujiwara differs from claim 18 in that although he discloses that his invention relates to a data processing apparatus **such as** a reading apparatus (emphasis added) (column 1, lines 6-7), he does not clearly disclose that the apparatus is a printer.

Trask discloses a printer comprising an envelope/sheet feeder comprising a removable envelope tray (34) positioned above a sheet feed tray (26), wherein the sheets from both tray may be selectively fed to a registration surface (60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara wherein the feed trays are utilized in a data processing apparatus such as a printer. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fujiwara by the teaching of Trask in order to obtain a more compact feeding system.

With regard to claim 20, Fujiwara discloses positioning the entire media holder in the media tray (figure 6).

Art Unit: 2626

With respect to claims 21, 22, 23, Fujiwara discloses a clamp (3) movable between a clamped position, wherein the clamp is configured to engage the media, and an unclamped position, wherein the clamp is resiliently biased towards the unclamped position (figure 2).

With regard to claim 32, Fujiwara discloses the holder is configured to be fully withdrawn from the tray (figure 2).

Response to Arguments

8. Applicant's arguments with respect to claims 1-13, 15-18, and 20-39 have been considered but are moot in view of the new ground(s) of rejection.

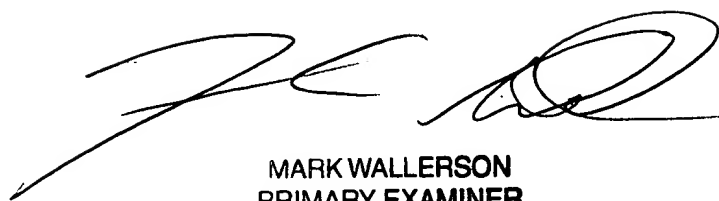
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2626

Mark E. Wallerson
Primary Examiner
Art Unit 2626

A handwritten signature in black ink, appearing to read 'Mark E. Wallerson', with a stylized, cursive script.

MARK WALLERSON
PRIMARY EXAMINER